

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

EBAY INC.; and MICROSOFT  
CORPORATION,

Plaintiffs,

v.

KELORA SYSTEMS, LLC,

Defendant.

No. C 10-4947 CW

ORDER ON CLAIM  
CONSTRUCTION AND  
GRANTING MOTION  
FOR SUMMARY  
JUDGMENT

(Docket Nos. 94 in  
10-4947, 57 in  
11-1398 and 361 in  
11-1548)

CABELA'S INC.,

Plaintiff,

v.

KELORA SYSTEMS, LLC,

Defendant.

No. C 11-1398 CW

KELORA SYSTEMS, LLC,

Plaintiff,

v.

TARGET CORPORATION; AMAZON.COM,  
INC.; DELL, INC.; OFFICE DEPOT,  
INC.; NEWEGG INC.; COSTCO  
WHOLESALE CORPORATION; HEWLETT-  
PACKARD COMPANY; AUDIBLE, INC.;  
and ZAPPOS.COM, INC.,

Defendants.

No. C 11-1548 CW

AND ALL RELATED COUNTERCLAIMS

Plaintiffs and Counterclaim-Defendants eBay, Inc., Microsoft  
Corporation and Cabela's Inc., Defendants and

1 Counterclaim-Plaintiffs Target Corporation, Amazon.com, Inc.,  
2 Dell, Inc., Office Depot, Inc., Newegg, Inc., Costco Wholesale  
3 Corporation, Hewlett-Packard Company, Audible, Inc. and  
4 Zappos.com, Inc. (hereinafter, collectively referred to as  
5 Defendants) and Defendant/Counterclaim-Plaintiff and  
6 Plaintiff/Counter-claim Defendant Kelora Systems, LLC  
7 (hereinafter, Kelora) seek construction of terms and phrases used  
8 in Kelora's U.S. Patent No. 6,275,821 ('821 patent). In addition,  
9 Defendants move for summary judgment of non-infringement and  
10 invalidity of the '821 patent. Kelora opposes their motion.  
11 Having considered the papers submitted by the parties and their  
12 oral arguments, the Court construes the terms and phrases as set  
13 forth below. In addition, the Court GRANTS Defendants' motion for  
14 summary judgment.

#### 15 BACKGROUND

16 Kelora Systems LLC is the current owner of the '821 patent,  
17 which is entitled, "Method and System for Executing a Guided  
18 Parametric Search," and claims a "process for identifying a single  
19 item from a family of items." '821 patent, Abstract. The  
20 invention is intended "to provide a guided parametric search to  
21 isolate a subfamily of items within a family of items based on  
22 alternatives associated with each item." Id. at 3:36-39. The  
23 patent specification describes two embodiments of the invention:  
24 (1) an embodiment that runs on a single, local computer, see id.  
25 at 5:50-18:9; and (2) an embodiment that runs over the Internet  
26 and requires a server and client computer, see id. at 18:10-  
27 19:34. Over the Internet, "the invention . . . may be used as an  
28 electronic catalog, providing an electronic alternative to

1 updating and distributing product and/or service information."

2 Id. at 4:6-9.

3 The '821 patent is the continuation of U.S. Patent No. 5,983,  
4 219, which is itself a continuation of U.S. Patent No. 5,715,444  
5 ('444 patent). The application for the '444 patent was filed on  
6 October 14, 1994. Defs.' Claim Construction Brief and Mot. for  
7 Summary J. (Mot.), Ex. 6.

8 A previous iteration of the '821 patent was at issue in a  
9 case previously before this Court, PartsRiver, Inc. v. Shopzilla,  
10 Inc., Case No. 09-0811 (N.D. Cal.). There, PartsRiver, the  
11 previous owner of the '821 patent, charged eBay and Microsoft with  
12 infringement. eBay and Microsoft counterclaimed for judgment of  
13 non-infringement and invalidity. The Court held that claims two  
14 and two of the patent were invalid based on the on-sale bar, 35  
15 U.S.C. § 102(b). In so holding, the Court found that those claims  
16 had been the subject of a commercial offer for sale in March and  
17 April 1992 and that they were reduced to practice in a  
18 demonstration program, referred to as AMP Navigator, by April  
19 1992. On September 18, 2009, PartsRiver appealed the Court's  
20 judgment of invalidity to the Federal Circuit.

21 While litigation before this Court was ongoing in the  
22 Partsriver case, the U.S. Patent and Trademark Office (PTO) was  
23 conducting an ex parte reexamination of claims one and two.  
24 There, the patent examiner initially rejected claims one and two  
25 as being clearly anticipated by prior art. PartsRiver sought  
26 reconsideration of this conclusion, arguing the prior art did not  
27 teach the subject matter contained in claim one. The patent  
28 examiner dismissed PartsRiver's arguments, concluding that

1 PartsRiver relied on features that did not appear in the language  
2 of the claims subject to reexamination. On or about September 18,  
3 2009, PartsRiver appealed the patent examiner's final rejection to  
4 the Board of Patent Appeals and Interferences (BPAI).

5 During the pendency of its appeals to the Federal Circuit and  
6 the BPAI, PartsRiver proposed amending claim one and adding a  
7 ninth claim to the '821 patent. PartsRiver's amendments to claim  
8 one necessarily changed dependent claim two. The patent examiner  
9 deemed claim one, as amended, and new claim nine to be patentable.  
10 Claims three and four were not re-examined. Thereafter,  
11 PartsRiver's BPAI appeal was dismissed. After a reexamination  
12 certificate for the '821 patent issued on November 2, 2010,  
13 PartsRiver filed a motion to dismiss its appeal of this Court's  
14 judgment, which the Federal Circuit granted.

15 In these related cases, Kelora, to whom Partsriver had  
16 transferred ownership of the '821 patent, and Defendants have  
17 filed various complaints and counter-complaints against each  
18 other, with Defendants seeking declarations of non-infringement,  
19 invalidity and/or intervening rights and Kelora alleging that  
20 Defendants have infringed the re-examined '821 patent. Kelora  
21 asserts against Defendants two independent claims, claims one and  
22 nine, and three dependent claims, claims two through four.

23 Claims one through four of the re-examined patent '821 are as  
24 follows, with additions to, and deletions from, the original claim  
25 one indicated in underlined text and brackets respectively:

26 1. A method for assisting a user in identifying a  
27 subfamily of items within a family of items said method  
28 performed with a server connected to a client computer  
through a computer network, comprising the steps of:

1 (a) providing a computer readable data file of  
2 stored information representing at least one family of  
3 items, said data file identifying at least one  
4 alternative for each item,

5 (b) reading said data file,

6 (c) displaying a feature screen indicating said  
7 alternatives represented in the family,

8 (d) accepting a first selection criteria of at  
9 least one alternative,

10 (e) determining a first subfamily of items wherein  
11 each said item in the first subfamily satisfies said  
12 first selection criteria,

13 (f) determining available alternatives represented  
14 in the first subfamily,

15 (g) revising said feature screen to indicate the  
16 available alternatives of the first subfamily,

17 (h) accepting a second selection criteria  
18 [comprising] from the client computer via said computer  
19 network at said server wherein the second selection  
20 criteria comprises a resubmission to the server of the  
21 alternative or alternatives of the first selection  
22 criteria plus at least one alternative selected from the  
23 revised feature screen,

24 (i) determining a second subfamily of items of the  
25 family wherein each item in the second subfamily  
26 satisfies said second selection criteria,

27 (j) determining available alternatives represented  
28 in the second subfamily, and

(k) revising said feature screen to indicate the  
available alternatives of the second subfamily.

2. The method of claim 1 wherein each family has at  
least one feature associated therewith and further  
comprising the step of displaying at least one grouping  
wherein each said grouping comprises one of said  
features visually related to respective alternatives.

3. The method according to claim 2 and further  
comprising the step of: providing an interactive pointer  
and displaying information specific to one of said  
features upon a user initiated signal when said pointer  
is pointing to a feature caption on said feature screen.

4. The method according to claim 2 wherein at least  
one said grouping is hidden from view if all said  
respective alternatives are not available.

1 Mot., Ex. 2, at 20:5-20, and Ex. 3, at 1:26-2:7. The text of new  
2 claim nine reads as follows,

3 9. A method for assisting a user in identifying a  
4 subfamily of items within a family of items, the method  
5 comprising the following steps which are performed with  
a server connected to a computer network:

6 (a) providing a computer readable data file of  
7 stored information representing at least one family of  
8 items, said data file identifying at least one  
9 alternative for each item,

10 (b) reading said data file,

11 (c) displaying a feature screen indicating said  
12 alternatives represented in the family, wherein data is  
13 output to a client computer via said computer network,

14 (d) receiving and accepting a first selection  
15 criteria of at least one alternative from said client  
16 computer, said first selection criteria being received  
17 by said server from said client computer via said  
computer network,

18 (e) determining a first subfamily of items wherein  
19 each said item in the first subfamily satisfies said  
20 first selection criteria,

21 (f) determining available alternatives represented  
22 in the first subfamily,

23 (g) revising said data for said feature screen to  
24 indicate the available alternatives of the first  
25 subfamily and outputting said revised data for said  
26 feature screen to said client computer via said computer  
27 network,

28 (h) receiving and accepting a second selection  
criteria from the client computer via said computer  
network at said server wherein the second selection  
criteria comprises (1) a resubmission by the client  
computer of the alternative or alternatives of the first  
selection criteria along with (2) at least one  
alternative selected from the revised feature screen,

(i) determining a second subfamily of items of the  
family wherein each item in the second subfamily  
satisfies said second criteria,

(j) determining available alternatives represented  
in the second subfamily, and

(k) revising said data for said feature screen to indicate the available alternatives of the second subfamily and outputting said revised data for said feature screen to said client computer via said computer network.

Mot., Ex. 3, at 2:8-50.

Defendants now move for summary judgment of non-infringement and invalidity of the '821 patent based on obviousness and broadening during re-examination.<sup>1</sup>

#### DISCUSSION

##### I. Claim Construction

##### A. Legal Standard

The construction of a patent is a matter of law for the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996). "It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.'" Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1115 (Fed. Cir. 2004)). Accordingly, in construing disputed terms, the Court first looks to the words of the claims. Vitronics Corp. v. Conceptoronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996).

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<sup>1</sup> After the hearing on claim construction and Defendants' motion for summary judgment, the Court invited the parties to submit supplemental briefs and additional expert reports on a limited issue. Defendants argue that, in its supplemental brief and expert reports, Kelora has included arguments and evidence that go far beyond the subject matter that the Court gave it leave to address, and requests that the Court decline to consider this information. The Court has reviewed Kelora's supplemental submissions and finds that they do exceed the scope of the Court's prior order. However, the Court OVERRULES Defendants' objection as moot, because the Court has considered the arguments and evidence that exceed the scope and has found that they do not change the result of this Order.

1 Generally, the Court ascribes the words of a claim their ordinary  
2 and customary meaning. Id. The Federal Circuit instructs that  
3 "the ordinary and customary meaning of a claim term is the meaning  
4 that the term would have to a person of ordinary skill in the art  
5 in question at the time of the invention, i.e., as of the  
6 effective filing date of the patent application." Phillips, 415  
7 F.3d at 1313. Other claims of the patent in question can also  
8 assist in determining the meaning of a claim term. Id. at 1314.  
9 "Because claim terms are normally used consistently throughout the  
10 patent, the usage of a term in one claim can often illuminate the  
11 meaning of the same term in other claims." Id.

12 The Federal Circuit also instructs that claims "must be read  
13 in view of the specification, of which they are a part." Id. at  
14 1315 (quoting Markman v. Westview Instruments, Inc., 52 F.3d 967,  
15 979 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996)). The  
16 specification must contain a description of the invention that is  
17 clear and complete enough to enable those of ordinary skill in the  
18 art to make and use it, and thus the specification is "always  
19 highly relevant" to the Court's claim construction analysis.  
20 Vitronics, 90 F.3d at 1582. "Usually, [the specification] is  
21 dispositive; it is the single best guide to the meaning of a  
22 disputed term." Id. In some cases, the specification may reveal  
23 that the patentee has given a special definition to a claim term  
24 that differs from its ordinary meaning; in such cases, "the  
25 inventor's lexicography controls." Phillips, 415 F.3d at 1316.  
26 The specification also may reveal the patentee's intentional  
27 disclaimer or disavowal of claim scope. "In that instance as  
28 well, the inventor has dictated the correct claim scope, and the



1 inventor's intention, as expressed in the specification, is  
2 regarded as dispositive." Id. However, claims are not limited to  
3 the preferred embodiment described in the specification. See SRI  
4 Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1121 (Fed.  
5 Cir. 1985) (en banc, plurality opinion).

6 In addition to reviewing the specification, the Court  
7 considers the patent's prosecution history. Markman, 52 F.3d at  
8 980. The prosecution history is intrinsic evidence that "can  
9 often inform the meaning of the claim language by demonstrating  
10 how the inventor understood the invention and whether the inventor  
11 limited the invention in the course of prosecution, making the  
12 claim scope narrower than it would otherwise be." Phillips, 415  
13 F.3d at 1317 (citing Vitronics, 90 F.3d at 1582-83); see also  
14 Chimie v. PPG Indus., Inc., 402 F.3d 1371, 1384 (Fed. Cir. 2005)  
15 ("The purpose of consulting the prosecution history in construing  
16 a claim is to exclude any interpretation that was disclaimed  
17 during prosecution.") (internal quotations omitted). However, the  
18 Court may find that the inventor "disclaimed protection during  
19 prosecution only if the allegedly disclaiming statements  
20 constitute 'a clear and unmistakable surrender of subject  
21 matter.'" Ecolab, Inc. v. FMC Corp., 569 F.3d 1335, 1342 (Fed.  
22 Cir. 2009) (quoting Bayer AG v. Elan Pharm. Research Corp., 212  
23 F.3d 1241, 1251 (Fed. Cir. 2000)).

24 While emphasizing the importance of intrinsic evidence in  
25 claim construction, the Federal Circuit has authorized courts to  
26 rely on extrinsic evidence, which consists of "all evidence  
27 external to the patent and prosecution history, including expert  
28 and inventor testimony, dictionaries, and learned treatises."

1 Phillips, 415 F.3d at 1317 (quoting Markman, 52 F.3d at 980).  
 2 Although extrinsic evidence may be useful to the Court, it is less  
 3 significant than intrinsic evidence in determining the legally  
 4 operative meaning of claim language. Phillips, 415 F.3d at 1317-  
 5 18; see also C.R. Bard, Inc. v. U.S. Surgical Corp., 388 F.3d 858,  
 6 862 (Fed. Cir. 2004). Furthermore, extrinsic evidence is unlikely  
 7 to lead to a reliable interpretation of claim language unless  
 8 considered in the context of the intrinsic evidence. Phillips,  
 9 415 F.3d at 1319.

#### 10 B. Discussion

11 The parties dispute the meaning of more than a dozen words or  
 12 phrases in claims one through four and nine of the amended patent  
 13 and one in the original claim one. The disputed terms and phrases  
 14 appear in other places in the patent as well.

15 Because the Court grants Defendants' motion for summary  
 16 judgment, the Court need not construe disputed terms beyond the  
 17 extent necessary for resolution of this motion.

#### 18 1. "User"

19 In their motion, Defendants argue that the word "user" means  
 20 "a person using a computer."<sup>2</sup> Mot. at 55. Kelora does not  
 21 challenge this construction or propose an alternative.

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22  
 23 <sup>2</sup> Throughout their motion, Defendants cite a table that they  
 24 include as Exhibit 1 to their motion. This table has  
 25 "[a]dditional evidence in support of Defendants' proposed  
 26 construction[s]," which they do not include or discuss in their  
 27 brief "[d]ue to space limitations." Mot. at 37, n.23. Kelora  
 28 challenges the consideration of this table, arguing that  
 Defendants "merely seek to circumvent the already extended page  
 limit for Defendants' brief" by including a table with "arguments  
 not deemed worthy of discussion in Defendants' Motion." Opp. at  
 60. The Court SUSTAINS Kelora's objection and declines to  
 consider Defendants' Exhibit 1.

1 Accordingly, the Court adopts Defendants' proposed construction  
2 and construes "user" to mean a "person using a computer."

3 2. "Server"

4 Defendants contend that the word "server" need not be  
5 construed. Kelora states that the word "server" as used  
6 throughout the claims refers to a "web server." Kelora argues  
7 that the word "server" was limited to a "web server" during the  
8 prosecution history of the '821 patent to distinguish it from  
9 prior art. Defendants reply that Kelora's proposed construction  
10 is incorrect, and that the cited pages from the prosecution  
11 history do not constitute a "clear and unmistakable waiver of  
12 subject matter."

13 The portions of the prosecution history cited by Kelora do  
14 not constitute a clear and unmitakeable waiver of subject matter.  
15 Kelora relies on a response sent by the patentee to the  
16 Commissioner for Patents, requesting reconsideration of the  
17 rejection of the original claims one and two. As noted by  
18 Defendants, the claims addressed at the time did not include the  
19 words "server," and the letter did not propose any amendments to  
20 the claims. Reexam. Ex. 5, at 2-5. In the discussion, the  
21 patentee used the word "webserver" in paragraphs that were  
22 intended to provide an example of how the patented method  
23 addressed a problem that servers faced. See id. at 10 ("A  
24 concrete example may be helpful here. Assume a webserver . .  
25 ."). In fact, the surrounding sentences use the word "server,"  
26 with no qualification, as the more general term. See id. ("In  
27 typical client server applications, the server establishes a  
28 separate session with each user . . ."). There is no language

1 that provides a clear and unmistakable waiver of subject matter  
2 related to any server that is not a web server.

3 Accordingly, the Court declines to construe the word server  
4 to be limited to a web server.

5 3. "With a server"

6 Kelora argues in an indirect manner that the phrase "with a  
7 server" should be construed to mean "by a server." Kelora states  
8 that the use of this phrase in the preamble means that all of the  
9 steps in claims one and nine require no action by any entity other  
10 than a server, specifically, no action by a client computer, and  
11 that the "server performs each step." See Opp. at 47, 48.

12 Defendants respond that this construction is incorrect, because  
13 the plain terms of the preamble allow some of the steps to be  
14 performed by a client computer as long as it is connected with the  
15 server when the step is performed.

16 As Defendants point out, this Court has already found that  
17 the steps in the claims do require some action by a client  
18 computer. In the Order of May 9, 2011, the Court recognized that,  
19 in step (h) of amended claim one and claim nine, tasks are divided  
20 between the client computer and the server, and that "the client  
21 computer combines 'the alternative or alternatives of the first  
22 selection criteria plus at least one alternative selected from the  
23 revised feature screen,' which, together, constitute the 'second  
24 selection criteria.'" Order Granting in Part and Denying in Part  
25 Plaintiffs' Motion for Summary Judgment and Consolidating Cases,  
26 Docket No. 70 in Case No. 10-4947, at 7-8.

27 Further, the clear terms of the specification support  
28 Defendants' interpretation. The specification describes, for

1 example, that the client computer, and not the server, performs  
2 the step of "displaying." See below, section I.B.4, "Displaying."

3 Accordingly, the Court declines to construe the phrase "with  
4 a server" to mean "by a server." The phrase need not be  
5 construed.

6 4. "Displaying"

7 Defendants propose that the word "displaying" should be  
8 construed as "showing on the display device of the user's  
9 computer." Kelora contends that the word should be construed as  
10 "the action of sending a page to a display surface or device for  
11 viewing."

12 Defendants' proposed construction is more consistent with the  
13 claim language. Step (c) of the newly added claim nine differs  
14 from step (c) of claim one, which did not change during  
15 re-examination, only by the addition of "wherein data is output to  
16 a client computer via said computer network." Kelora argues that  
17 this clause means that "displaying" must include the concept of  
18 outputting. However, if "displaying" were construed to include  
19 this already, the additional phrase in claim nine would be  
20 superfluous, and step (c) in each claim would have the same  
21 meaning. Both parties point out, "A claim construction that gives  
22 meaning to all terms of the claim is preferred over one that does  
23 not." Merck & Co. v. Teva Pharms. USA, Inc., 395 F.3d 1364, 1372  
24 (Fed. Cir. 2005). Defendants' proposed construction renders this  
25 additional phrase meaningful and allows step (c) to be  
26 differentiated between the two claims.

27 Kelora also argues that Defendants' construction disregards  
28 language from the preamble of claims one and nine, which states

1 that the steps are "performed with a server connected [. . .] to a  
2 computer network." However, the preamble does not specify that  
3 the steps are all performed by the server. Instead, the  
4 specification makes clear that the display step is performed by "a  
5 client," in conjunction with a server sending data to the client,  
6 and not by the server alone.

7 In arguing that "displaying" is defined in part as "sending,"  
8 Kelora states that "the specification describes the act of  
9 'displaying' by the server in the Internet embodiments," and "that  
10 the client then merely reflects what the server sends it." Opp.  
11 at 50 (citing Mot., Ex. 2, 18:48-54, 61-63). However, this  
12 inaccurately describes the contents of the specification.  
13 Instead, the specification clearly distinguishes between "sending"  
14 and "displaying," and states that the server computer performs the  
15 former and the client computer performs the latter. See Ex. 2,  
16 18:49, 61-63 ("the server sends a feature screen status . . . The  
17 client receives the feature screen status and displays the feature  
18 screen accordingly."). These two words are consistently used in a  
19 non-interchangeable manner, and the division of roles is  
20 reiterated, elsewhere in the specification. See id. at 19:6-10  
21 ("The server sends the feature screen status . . . to the client.  
22 The client receives the feature screen status and displays the  
23 updated feature screen."). The specification also makes clear  
24 that the client refers to the user's computer. See, e.g., id. at  
25 18:12-13 (distinguishing between the server computer and the  
26 client computer); 18:45 ("a user on the client"); 18:64 ("The user  
27 on the client"). Thus, Kelora's proposed construction is not  
28

1 consistent with the language of the specification, while  
2 Defendants' proposal is.

3 Defendants' proposed construction is also consistent with the  
4 prosecution history of the '821 patent. Defendants point out  
5 that, during the re-examination process, the patentees proposed a  
6 new claim one in which the step of "displaying" was replaced with  
7 a step of "outputting data for a feature screen." Mot. at 48  
8 (citing '821 Reexam., Ex. 8 at 5). They later reverted to the  
9 "displaying" language in the final amendment, which demonstrates  
10 that the patentees deliberately chose not to use the word  
11 "outputting." Id. In response, Kelora argues only that the  
12 addition of the phrase "wherein data is output to" supports its  
13 construction, which is unavailing for the reasons addressed above.

14 Finally, the inventor testimony offered is also consistent  
15 with Defendants' position that "displaying" refers to the browser  
16 "showing," as distinguished from the server "sending." See Opp.  
17 at 51 (quoting deposition testimony of inventor Sherif Danish that  
18 "it is a function of the server to determine what is this feature  
19 screen and send it to the browser, and the browser will interpret  
20 it and visualize it for the user" and "the browser can only  
21 display what it receives"); Mot. at 48 (inventor Mr. Danish  
22 agreeing that "the browser process[es] HTML code that it receives  
23 from the server," formats it, and then "displays it on the  
24 screen," and that "the display is . . . a display that happens on  
25 the user of the--on the browser of the client").

26 Thus, the Court construes the word "displaying" to mean  
27 "showing on the display device of the user's computer."  
28

## 5. "Resubmission"

Kelora contends that the phrase "resubmission to the server," which appears in claim one and nine, does not need to be construed. Defendants argue that this phrase does need to be construed in claim one, but not in claim nine, where it is followed by the phrase "by said client computer." Defendants propose that the phrase in claim one should be construed as "resubmission by said client computer to the server." Kelora responds with two arguments: that Defendants' construction improperly changes a noun to a verb requiring action, and that requiring this action to be done by the client computer violates the limitation of the preamble that the steps are to be "performed with a server."

First, Kelora's argument that Defendants' construction improperly changes a noun to a verb is unpersuasive. Kelora is correct that the word "resubmission" is a noun; however, contrary to Kelora's contentions, nouns can describe actions and not all words that describe actions are verbs. See, e.g., Webster's Third New International Dictionary 1545 (Philip Babcock Gove ed., 1993) (defining a noun as "a word that is the name of a subject of discourse (as a person, animal, plant, place, thing, substance, quality, idea, action, or state)"); Merriam-Webster Dictionary (May 18, 2012, 2:04 p.m.), <http://www.merriam-webster.com/dictionary/noun> (defining a noun as "any member of a class of words that typically can be combined with determiners to serve as the subject of a verb, can be interpreted as singular or plural, can be replaced with a pronoun, and refer to an entity, quality, state, action, or concept"). Resubmission is such a



1 noun. See Webster's Third New International Dictionary, above, at  
2 1937 ("resubmission" is a noun defined as "an act of  
3 resubmitting").

4 As Defendants point out, the plain text of the claim and the  
5 specification demonstrate that the resubmission is something that  
6 the client computer sends to the server. The claim describes a  
7 step of "accepting a second selection criteria from said client  
8 computer . . . wherein the second selection criteria comprises a  
9 resubmission to the server . . ." Mot., Ex. 3 at 1:46-50. The  
10 specification explains that the user on the client computer "makes  
11 selections," and the client computer "initiates a search with the  
12 modified selection criteria" and "sends to the server, the  
13 ScreenNum value . . . and the modified selection criteria." Mot.,  
14 Ex. 3 at 18:64-19:2. In turn, the "server receives" these items  
15 and "executes the search operation." Id. at 19:3-5. That the  
16 resubmission is sent from the client computer to the server is  
17 also supported by the re-examination history: when allowing the  
18 re-examined claims, the Examiner stated that "when the client  
19 computer of claims 1 or 9 submits a second query, it transmits  
20 both the previous and current selection criteria together." '821  
21 Reexam., Ex. 16 at 3.

22 Kelora responds that this construction would "render  
23 superfluous" the limitation in the preamble that the steps are  
24 performed "with a server." Opp. at 12. However, allocating  
25 actions between the server and client computer does not render  
26 "with a server" superfluous; the client computer must send the  
27 resubmission to the server, as is evident from the claims  
28 themselves.

1 Accordingly, the Court construes the phrase "resubmission to  
2 the server" to mean "resubmission by said client computer to the  
3 server."

4 II. Motion for Summary Judgment

5 A. Legal Standard

6 Summary judgment is properly granted when no genuine and  
7 disputed issues of material fact remain, and when, viewing the  
8 evidence most favorably to the non-moving party, the movant is  
9 clearly entitled to prevail as a matter of law. Federal Rule  
10 Civil Procedure 56; Celotex Corp. v. Catrett, 477 U.S. 317, 322-23  
11 (1986); Eisenberg v. Ins. Co. of N. Am., 815 F.2d 1285, 1288-89  
12 (9th Cir. 1987).

13 The moving party bears the burden of showing that there is no  
14 material factual dispute. Therefore, the court must regard as  
15 true the opposing party's evidence, if supported by affidavits or  
16 other evidentiary material. Celotex, 477 U.S. at 324; Eisenberg,  
17 815 F.2d at 1289. The court must draw all reasonable inferences  
18 in favor of the party against whom summary judgment is sought.  
19 Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574,  
20 587 (1986); Intel Corp. v. Hartford Accident & Indem. Co., 952  
21 F.2d 1551, 1558 (9th Cir. 1991).

22 Material facts which would preclude entry of summary judgment  
23 are those which, under applicable substantive law, may affect the  
24 outcome of the case. The substantive law will identify which  
25 facts are material. Anderson v. Liberty Lobby, Inc., 477 U.S.  
26 242, 248 (1986).

1       Where the moving party does not bear the burden of proof on  
2 an issue at trial, the moving party may discharge its burden of  
3 production by either of two methods:

4           The moving party may produce evidence negating  
5 an essential element of the nonmoving party's  
6 case, or, after suitable discovery, the moving  
7 party may show that the nonmoving party does not  
8 have enough evidence of an essential element of  
9 its claim or defense to carry its ultimate  
10 burden of persuasion at trial.

11 Nissan Fire & Marine Ins. Co., Ltd., v. Fritz Cos., Inc., 210 F.3d  
12 1099, 1106 (9th Cir. 2000).

13       If the moving party discharges its burden by showing an  
14 absence of evidence to support an essential element of a claim or  
15 defense, it is not required to produce evidence showing the  
16 absence of a material fact on such issues, or to support its  
17 motion with evidence negating the non-moving party's claim. Id.;  
18 see also Lujan v. Nat'l Wildlife Fed'n, 497 U.S. 871, 885 (1990);  
19 Bhan v. NME Hosps., Inc., 929 F.2d 1404, 1409 (9th Cir. 1991). If  
20 the moving party shows an absence of evidence to support the non-  
21 moving party's case, the burden then shifts to the non-moving  
22 party to produce "specific evidence, through affidavits or  
23 admissible discovery material, to show that the dispute exists."  
24 Bhan, 929 F.2d at 1409.

25       If the moving party discharges its burden by negating an  
26 essential element of the non-moving party's claim or defense, it  
27 must produce affirmative evidence of such negation. Nissan, 210  
28 F.3d at 1105. If the moving party produces such evidence, the  
burden then shifts to the non-moving party to produce specific  
evidence to show that a dispute of material fact exists. Id.

1 If the moving party does not meet its initial burden of  
2 production by either method, the non-moving party is under no  
3 obligation to offer any evidence in support of its opposition.  
4 Id. This is true even though the non-moving party bears the  
5 ultimate burden of persuasion at trial. Id. at 1107.

6 Where the moving party bears the burden of proof on an issue  
7 at trial, it must, in order to discharge its burden of showing  
8 that no genuine issue of material fact remains, make a prima facie  
9 showing in support of its position on that issue. UA Local 343 v.  
10 Nor-Cal Plumbing, Inc., 48 F.3d 1465, 1471 (9th Cir. 1994). That  
11 is, the moving party must present evidence that, if uncontroverted  
12 at trial, would entitle it to prevail on that issue. Id.; see  
13 also Int'l Shortstop, Inc. v. Rally's, Inc., 939 F.2d 1257, 1264-  
14 65 (5th Cir. 1991). Once it has done so, the non-moving party  
15 must set forth specific facts controverting the moving party's  
16 prima facie case. UA Local 343, 48 F.3d at 1471. The non-moving  
17 party's "burden of contradicting [the moving party's] evidence is  
18 not negligible." Id. This standard does not change merely  
19 because resolution of the relevant issue is "highly fact  
20 specific." Id.

21 B. Summary Judgment of Invalidity due to Obviousness

22 Under 35 U.S.C. § 103(a), a patent is invalid "if the  
23 differences between the subject matter sought to be patented and  
24 the prior art are such that the subject matter as a whole would  
25 have been obvious at the time the invention was made to a person  
26 having ordinary skill in the art to which said subject matter  
27 pertains." To avoid being obvious, a patent must be "more than  
28 the predictable use of prior art elements according to their

1 established functions." KSR Int'l Co. v. Teleflex Inc., 550 U.S.  
2 398, 417 (2007). To determine obviousness, "the invention must be  
3 considered as a whole and the claims must be considered in their  
4 entirety." Kahn v. General Motors Corp., 135 F.3d 1472, 1479  
5 (Fed. Cir. 1998).

6 "Although the ultimate determination of obviousness under  
7 § 103 is a question of law, it is based on several underlying  
8 factual findings, including (1) the scope and content of the prior  
9 art; (2) the level of ordinary skill in the pertinent art; (3) the  
10 differences between the claimed invention and the prior art; and  
11 (4) evidence of secondary factors, such as commercial success,  
12 long-felt need, and the failure of others." Retractable Techs.,  
13 Inc. v. Becton, 653 F.3d 1296, 1310 (Fed. Cir. 2011) (citing  
14 Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966)). "Where . . .  
15 the content of the prior art, the scope of the patent claim, and  
16 the level of ordinary skill in the art are not in material  
17 dispute, and the obviousness of the claim is apparent in light of  
18 these factors, summary judgment is appropriate." KSR, 550 U.S. at  
19 427.

20 The Court is not required to accept blindly conclusory  
21 assertions made by the parties' experts. In KSR, the Supreme  
22 Court rejected the approach that the patentee can necessarily  
23 create a material question of fact by proffering a conclusory  
24 expert affidavit. See 127 S. Ct. at 1745 ("To the extent the  
25 court understood the Graham approach to exclude the possibility of  
26 summary judgment when an expert provides a conclusory affidavit  
27 addressing the question of obviousness, it misunderstood the role  
28 expert testimony plays in the analysis."). Thus, when considering

1 summary judgment on the question of obviousness, "the district  
2 court can and should take into account expert testimony, which may  
3 resolve or keep open certain questions of fact," but expert  
4 testimony is not the end of discussion, because "[t]he ultimate  
5 judgment of obviousness is a legal determination." Id.

6 Defendants contend that the re-examined '821 patent is  
7 obvious, based on a combination of the AMP Navigator program,  
8 which this Court found was prior art for the original '821 patent,  
9 with other prior art.

10 1. The hypothetical person of ordinary skill in the  
11 art

12 The parties agree that "a low level of skill in the art" is  
13 the appropriate standard to use. While Defendants define this as  
14 "a person with a moderate level of computer science experience  
15 acquired through either formal or informal training," Mot. at 29,  
16 n.18, Kelora defines it as someone with "2-3 years of experience  
17 or education with computer programming and familiarity with  
18 standards that had been established at the time," Opp. at 20. The  
19 difference between these two definitions, if any, is not material  
20 to the resolution of this motion. Thus, the Court adopts Kelora's  
21 proposed definition for the purposes of this order.

22 In its supplemental opposition, Kelora refers to anecdotal  
23 evidence from one of its experts about her first-hand experience  
24 reviewing solutions generated by computer science and engineering  
25 students in response to an assignment to adapt a computer  
26 application with search capability to a networked application.  
27 Kelora argues that, because none of these students adapted the  
28 application to the Web or to use resubmission, such steps were not

1 obvious to a person of ordinary skill in the art. Kelora's other  
2 expert also refers to the fact that the inventors themselves were  
3 unfamiliar with web servers until the second quarter of 1994 and  
4 could not have adapted the invention to the Web before that time.  
5 However, this evidence is not determinative. "The issue of  
6 obviousness is determined entirely with reference to a  
7 hypothetical 'person having ordinary skill in the art.'" Std. Oil  
8 Co. v. Am. Cyanamid Co., 774 F.2d 448, 454 (Fed. Cir. 1985).  
9 Thus, the actual skills displayed or solutions derived by any  
10 particular person or people are irrelevant to the inquiry. See,  
11 e.g., id. (stating that, because the focus is on a hypothetical  
12 person, the "actual inventor's skill is irrelevant to the  
13 inquiry"). Further, even if the students were of ordinary skill  
14 in the art, the fact that the students did not choose to go beyond  
15 the basic requirements of a school assignment to adapt their  
16 applications to the Web or use resubmission does not establish or  
17 suggest that they lacked the skills to do so with the appropriate  
18 motivation. Similarly, there is no showing that these students  
19 had access to all prior art references at the time, or that they  
20 viewed the collective teachings of the prior art "as a whole," as  
21 is presumed of the hypothetical person of ordinary skill. See  
22 Std. Oil, 774 F.2d at 454; In re Gorman, 933 F.2d 982, 986 (Fed.  
23 Cir. 1991).

24 2. The scope and content of the prior art

25 Prior art refers to "knowledge that is available, including  
26 what would be obvious from it, at a given time, to a person of  
27 ordinary skill in an art." Kimberly-Clark Corp. v. Johnson &  
28 Johnson, 745 F.2d 1437, 1453 (Fed. Cir. 1984). Under section 103,

1 the relevant content for the obviousness analysis is what was in  
2 the prior art "at the time of the invention was made." 35 U.S.C.  
3 § 103.

4 a. The time of invention

5 For consideration of obviousness, the relevant prior "art  
6 must have existed as of the date of invention, presumed to be the  
7 filing date of the application until an earlier date is proved."  
8 Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443,  
9 449 (Fed. Cir. 1986). See also 35 U.S.C. § 103(a) (stating that  
10 the relevant consideration is what "would have been obvious at the  
11 time the invention was made"). The parties do not dispute that  
12 the relevant application filing date was August 14, 1994. See,  
13 e.g., Mot. at 19 n.6; Opp. at 22. See also Defs.' Exs. 2, 6.

14 Kelora, however, argues that there is a material dispute of  
15 fact as to whether the date of invention was during or before the  
16 second quarter of 1994. See Opp. at 22, 24. In support, Kelora  
17 cites its interrogatory responses, in which it states that the  
18 inventors, Kris Kimbrough and Mr. Danish, conceived of the  
19 Internet embodiment after taking a class on web servers that Mr.  
20 Danish learned of through a listserve that he joined in or before  
21 April 1994, and that the only witnesses to the conception were the  
22 two inventors. Id. (citing Mot., Ex. 15, at 5-6); see also Danish  
23 Decl. ¶ 1 (Mr. Danish is a managing member of Kelora). On that  
24 basis, Kelora argues that, because one of the claimed pieces of  
25 prior art, a message posted to the WWW-Talk listserve by Nick  
26  
27  
28



1 Arnett,<sup>3</sup> bears the date of May 16, 1994, there is a genuine issue  
2 of material fact as to whether the Arnett prior art was known to  
3 others or publicly available as a printed publication before the  
4 date of invention. Id.

5 However, inventor testimony alone is insufficient to  
6 establish a conception date. "It is well established that when a  
7 party seeks to prove conception via the oral testimony of a  
8 putative inventor, the party must proffer evidence corroborating  
9 that testimony." P&G v. Teva Pharms. USA, Inc., 566 F.3d 989, 999  
10 (Fed. Cir. 2009) (quoting Shu-Hui Chen v. Bouchard, 347 F.3d 1299,  
11 1309 (Fed. Cir. 2003)). See also Monolithic Power Sys. v. 02  
12 Micro Int'l Ltd., 2010 U.S. Dist. LEXIS 13106, at \*27 (N.D. Cal.)  
13 ("in addition to providing the testimony of the inventor, whose  
14 credibility can be judged by a jury, a patentee must offer  
15 independent corroborating evidence to establish a priority date  
16 earlier than the application filing date"). "Such evidence 'may  
17 consist of testimony of a witness, other than an inventor, to the  
18 actual reduction to practice or it may consist of evidence of  
19 surrounding facts and circumstances independent of information  
20 received from the inventor.'" Hahn v. Wong, 892 F.2d 1028, 1032-

21  
22  
23  
24 <sup>3</sup> Kelora objects to paragraphs four through ten of the  
25 declaration of Nick Arnett as hearsay and without foundation.  
26 Kelora does not object to the admissibility of Exhibit A to the  
27 declaration, which contains the message posted by Mr. Arnett. Mr.  
28 Arnett attests that the statements in the declaration are based on  
his personal knowledge; many of the statements within the  
challenged paragraphs describe his own activities, including  
comments that he made and messages that he received. Thus, to  
extent that the Court relies upon the Arnett declaration, Kelora's  
objection is OVERRULED.

1 1033 (Fed. Cir. 1989) (quoting Reese v. Hurst, 661 F.2d 1222, 1225  
2 (C.C.P.A. 1981)) (emphasis added).

3 Kelora has pointed only to the inventors' own statements to  
4 establish a conception date earlier than the application filing  
5 date, which is insufficient to support that finding as a matter of  
6 law. Therefore, there is no material dispute of facts that  
7 conception date is October 14, 1994, the application filing date  
8 of the '444 patent, or that Arnett is prior art.

9 b. AMP Navigator as prior art

10 Kelora also contests Defendants' use of the AMP Navigator  
11 demonstration program as prior art. Kelora argues that Defendants  
12 make no showing that the AMP Navigator program represents an on-  
13 sale bar to the re-examined claims or that it anticipates the re-  
14 examined claims by itself. This Court has already found that  
15 claims one and two of the original '821 patent were invalid "due  
16 to the on-sale bar because they were the subject of a commercial  
17 offer for sale of an invention that was reduced to practice before  
18 October 14, 1993." PartsRiver, Inc. v. Shopzilla, Inc., 2009 U.S.  
19 Dist. LEXIS 74433 (N.D. Cal.). Kelora does not argue that claims  
20 one and two of the original '821 patent were in fact valid or  
21 dispute Defendants' argument that it would be barred from doing so  
22 as the successor-in-interest to PartsRiver, Inc.

23 The Federal Circuit has clearly stated, "Prior art under the  
24 § 102(b) on-sale bar is also prior art for the purposes of  
25 obviousness under § 103." Dippin' Dots, Inc. v. Mosey, 476 F.3d  
26 1337, 1344 (Fed. Cir. 2007). See also TorPharm Inc. v. Ranbaxy  
27 Pharms., Inc., 336 F.3d 1322, 1327 (Fed. Cir. 2003). While Kelora  
28 argues that this is improper "bootstrapping" on the prior finding

1 of invalidity, the courts have repeatedly recognized that "Section  
2 102(b) may create a bar to patentability . . . in conjunction with  
3 [§ 103], if the claimed invention would have been obvious from the  
4 on-sale device in conjunction with the prior art." LaBounty Mfg.  
5 v. United States ITC, 958 F.2d 1066, 1071 (Fed. Cir. 1992). See  
6 also TorPharm, 336 F.3d at 1327-1328 (describing "the § 102(b)/103  
7 bar"); Pfaff v. Wells Elecs., 124 F.3d 1429, 1436 (Fed. Cir.  
8 1997), aff'd 525 U.S. 55 (1998) (same).

9 Kelora contends that "the law does not permit the AMP  
10 Navigator to be combined with other art that is created after the  
11 offer for sale . . . to show obviousness." Sur-reply at 4  
12 (emphasis omitted). However, Kelora cites no legal authority in  
13 support of the proposition that the Court should ignore the clear  
14 statutory language of § 103(a) that the prior art relevant to  
15 obviousness is that which existed "at the time the invention was  
16 made." For the purposes of obviousness, the relevant prior art  
17 consists of those sources that are otherwise "prior art for  
18 purposes of Section 103 . . . plus those sources enumerated in  
19 Section 102(b) with effective dates more than one year before the  
20 applicant's filing date." 2 Donald S. Chisum, Chisum on Patents  
21 § 5.03[2][b], at 5-133-134 (2012) (emphasis in original). See  
22 also Novo Nordisk A/S v. Caraco Pharm. Labs., Ltd., 2010 U.S.  
23 Dist. LEXIS 56752, at \*10-11 (E.D. Mich.).

24 In opposing Defendants' obviousness arguments, Kelora focuses  
25 on the source code of the AMP Navigator demonstration program and  
26 argues that a person of ordinary skill in the art would not have  
27 been able to transform that source code into a client server  
28 arrangement. However, these arguments are irrelevant. The prior

1 invalidity finding placed the claimed features that were the  
2 subject of the offer for sale--claims one and two of the original  
3 '821 patent--into the prior art for the obviousness inquiry, along  
4 with the specific reduction-to-practice and unclaimed limitations  
5 that were contained in the AMP Navigator demonstration program.  
6 See Pfaff v. Wells Elecs., 525 U.S. 55, 60 (1998) (stating that,  
7 in summarizing the lower court's obviousness inquiry, "[g]iven the  
8 [lower] court's § 102(b) holding, the prior art included [the  
9 patent's] first four claims"). See also Lockwood v. American  
10 Airlines, 107 F.3d 1565, 1570 (Fed. Cir. 1997) ("it is the claims  
11 that define a patented invention. . . . [the] public use of the  
12 high-level aspects of the SABRE system was enough to place the  
13 claimed features of the '359 patent in the public's possession").

14 This Court has already determined that the AMP Navigator  
15 demonstration program constituted a reduction to practice of the  
16 original claims and thus that all elements of the local embodiment  
17 of the original claims were obvious. Defendants are not required  
18 to re-litigate each of these, as Kelora urges, and AMP Navigator  
19 is prior art citable against the patent claims for obviousness  
20 purposes. Accordingly, Defendants may prove the obviousness of  
21 the current claims by showing that they would have been obvious  
22 from the combination of AMP Navigator, including the concept of  
23 parametric search, with other prior art, including the Arnett and  
24 Suzuki prior art.

25 Defendants contend that the only differences between the  
26 original and re-examined claims are the requirement of the client-  
27 server arrangement and the resubmission requirement for iterative  
28 searching, and that each of these elements was taught in the prior

1 art. See Mot. at 17; Reply at 9-10. In his declaration, Kelora's  
2 expert witness, Mr. Gafford, also identifies these as the two  
3 specific items that the AMP Navigator prior art does not teach,  
4 and which are contained in the re-examined '821 patent. See  
5 Gafford Decl. ¶¶ 34-39. See also Sur-reply at 3 (recognizing the  
6 same).

7 c. Client-server arrangements

8 Defendants argue that client-server arrangements were  
9 well-known and obvious, and rely on a number of prior art examples  
10 to demonstrate this. Kelora responds primarily that a client-"web  
11 server" system is not taught in the prior art, but does not  
12 dispute that a "client-server" system was taught.

13 Kelora argues that the AMP Navigator prior art "teaches away"  
14 from a web server arrangement, because the code for the AMP  
15 Navigator demonstration program does not have this functionality  
16 itself and cannot be altered to include it. Nonetheless, Kelora  
17 and Mr. Gafford do not dispute that the Suzuki<sup>4</sup> reference and AMP  
18 Navigator together teach the combination of the local search  
19 process contained in the original claim one with the use of a  
20 database on a remote server, even though Suzuki does not use the  
21

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22  
23 <sup>4</sup> The Suzuki reference is to a patent published by the Japan  
24 Patent Office on January 5, 1989, entitled "File Searching  
25 Method." Leventhal Decl., Ex. 2 at 321. Kelora objects to the  
26 English translation of the reference. The translation is  
27 accompanied by the declaration of Takeo Ohashi, who declares under  
28 penalty of perjury that he has "competent knowledge of the  
Japanese and English languages" and that the "translation is an  
accurate representation of" the original Japanese patent. Id. at  
340. Defendants have laid a proper foundation for the admission  
of the translated reference. See 28 U.S.C. § 1746; Federal Rules  
of Evidence 604, 702, 901. Accordingly, Kelora's objection is  
OVERRULED.

1 words "client" and "server." See Opp. at 32; see also Gafford  
2 Decl. ¶ 43 (recognizing that "combining Suzuki with the AMP  
3 Navigator demonstration program would have been expected by a  
4 person of ordinary skill in the art as of October 14, 1994, to  
5 have resulted, and would have resulted, in a system with the  
6 logical model of the AMP Navigator demonstration program, . . .  
7 coupled with a remote database").

8 Further, Defendants offer substantial evidence, uncontested  
9 by Kelora, that such an arrangement was common knowledge in the  
10 art prior to the time of invention and would have been obvious to  
11 try. Defendants cite statements from the Examiner during the  
12 examination of the grandparent patent to the patent-in-suit, when  
13 the Examiner considered a claim dependent on the claim from which  
14 the original claim one is derived and which is nearly identical to  
15 the original claim one. Mot. at 21 (citing '444 Prosecution, No.  
16 7 ¶ 28). The Examiner rejected as obvious the dependent claim,  
17 which added a client server arrangement, stating that "client  
18 server systems are well known in the art and it would have been  
19 obvious to one of ordinary skill in the DP art at the time of the  
20 applicant's invention to provide the invention also on a client  
21 server system as that would provide a wider range of utilization."  
22 '444 Prosecution, No. 7 ¶ 28. See also In re Bozek, 416 F.2d  
23 1385, 1390 (C.C.P.A. 1969) (noting that a patent examiner may  
24 properly rely on "common knowledge and common sense of the person  
25 of ordinary skill in the art" in making conclusions regarding  
26 obviousness). Kelora responds only that this statement is  
27 irrelevant as to whether one would be motivated to combine the  
28 present claim with a client server arrangement, but does not

1 dispute this as evidence that client server systems were well-  
2 known in the art prior to the invention of the disputed claims.  
3 Opp. at 37.

4 Defendants also offer PC Magazine's 1993 book, Guide to  
5 Client/Server Databases, which explains the concept of client-  
6 server database arrangements and various benefits associated with  
7 such systems. They also provide references to Tim Berners-Lee's  
8 development of the World Wide Web as an example of a client-server  
9 arrangement, which consisted of a server and client-side browser  
10 and which was available in 1992 and earlier. Defendants also cite  
11 Jason Ng's GSQL program, which taught the use of remote databases  
12 on a web server. Rather than disputing that these prior art  
13 references teach client-server arrangements, including client-web  
14 server arrangements, Kelora contends only that these references do  
15 not teach resubmission.

16 Accordingly, the Court finds that client-server systems were  
17 known at the time of invention to people of ordinary skill in the  
18 art, were obvious to try and were taught by prior art.

19 d. Resubmission

20 Similarly, the Court concludes that resubmission of all  
21 search terms was a method taught by the prior art to resolve the  
22 problem of statelessness.

23 "A 'stateless' server does not remember previous requests  
24 from a user." Larson II Decl. ¶ 26. Thus, from the perspective  
25 of the server, each request is treated independently and is  
26 unrelated to any other. Id. "For example, if a user submits  
27 search criteria to a stateless server, the server conducts a  
28 search, returns the search results to the user, and then 'forgets'

1 both the search and the results." Id. The HTTP protocol used on  
2 the Web is a stateless protocol. See, e.g., Leventhal Decl. Ex. 8  
3 at 1. Defendants offer evidence to support that persons of  
4 ordinary skill in the art knew of the Web's use of stateless  
5 servers. Larson II Decl. ¶ 35.

6 Such a design had critical advantages over a stateful server,  
7 such as to reduce the amount of disk storage and memory space  
8 required and to simplify crash recovery. Id. at ¶ 29. During the  
9 reexamination of the '821 patent, the inventors themselves  
10 acknowledged disadvantages of stateful servers on the World Wide  
11 Web. See '821 Reexam. Ex. 5 at 10 ("If the webserver has to  
12 identify and track individual sessions with each such user in  
13 order to know what criteria the user previously searched in  
14 earlier search iterations, there is clearly a tremendous overhead  
15 load on the webserver to service such individual search  
16 sessions.").

17 As previously stated, the Arnett reference consists of a  
18 message written by Mr. Arnett in May 1994 on the WWW-Talk  
19 listserve. "At the time of the invention, listserve were a venue  
20 for discussion by active implementers of particular systems or  
21 protocols." Larson II Decl. "WWW-Talk was one of the primary  
22 venues for discussion of WWW implementation issues." Id. In the  
23 message, Arnett remarks in part,

24 I'm working on an application that would take advantage  
25 of this sort of capability, but I don't think it  
26 requires abandonment of statelessness. My experience so  
27 far tells me that when the user wants to perform  
28 multiple queries and transfers, it's because they are  
somehow related to one another. I'm attacking the  
problem by passing parameters, which are kept by the  
\*browser\* and re-sent. I see the need for improvement  
of the browsers' ability to keep track of queries and



1 such, based on interaction, rather than a need to change  
the servers' capabilities in that area. . . .

2 At first glance, you'd think that that would require the  
3 server to record the state of the outline, but the  
4 people who've done it actually just create a document  
5 that contains a list of parameters describing the  
outline's state, then pass those parameters back to the  
server on each subsequent query. . . .

6 There's no reason that the subsequent query can't pass  
7 back to the server a set of parameters that describes  
the previous search results, to which new narrowing or  
widening parameters can be added.

8 Arnett Declaration, Ex. A at 1-2. Defendants contend, and their  
9 expert, Dr. Larson, supports that this constitutes resubmission.

10 Kelora responds that Arnett does not teach resubmission for  
11 several reasons. Kelora argues that Arnett teaches several  
12 different approaches to keeping previous search results, only one  
13 of which is resubmission of the original search terms along with  
14 the new search terms and that this would not have been the single  
15 solution necessarily chosen by a person of ordinary skill in the  
16 art. However, "mere disclosure of alternative designs does not  
17 teach away." In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004).  
18 Kelora concedes that Arnett discloses that "a client can resend  
19 certain parameters," admitting that Arnett describes a  
20 resubmission by a client. Kelora asserts instead that Arnett  
21 "teaches away" from resubmission by a server. Sur-reply at 6.  
22 This argument is premised on Kelora's argument for a construction  
23 that limits "resubmission" to something that a server does.  
24 Because the Court has already declined to adopt this construction,  
25 Kelora's argument is unavailing.

26 Kelora also contends that there may have been solutions to  
27 the problem of statelessness that would not have involved  
28 resubmission. See, e.g., Gafford II Decl. ¶ 15. However, the

1 fact that there are multiple solutions, only one of which was  
2 resubmission, does not mean resubmission was not obvious to try.  
3 As the Supreme Court recognized in KSR, "When there is a design  
4 need or market pressure to solve a problem and if there are a  
5 finite number of identified, predictable solutions to a problem, a  
6 person of ordinary skill has good reason to pursue the known  
7 options within his or her technical grasp." 550 U.S. at 421.

8 Kelora finally argues that, even though Arnett suggests that  
9 the client resubmit all earlier parameters in a successive search,  
10 the discussion in Arnett is not clear and at a high level of  
11 abstraction, without specific guidance as to how a person of  
12 ordinary skill at that time would be able to perform a  
13 resubmission. However, Arnett provides the same level of detail  
14 as the specification of the '821 patent itself does regarding how  
15 resubmission is performed. As background, the specification  
16 explains that, when a user makes a first selection,

17 the server 125 sends a feature screen status 127 to the  
18 client 126. The feature screen status 127 comprises a  
19 feature screen code, ScreenNum 102 in a preferred  
20 embodiment, all features 5 appropriate to the feature  
21 screen 9 specified in ScreenNum 102, all available  
22 alternatives 7, all unavailable alternatives 8, and the  
23 selection criteria 14. . . . It is apparent, therefore,  
24 that the server 125 sends all of the information  
25 necessary to define the current subfamily 2 to the  
26 client 126. The information, therefore need not be  
27 retained in memory on the server 125. This particular  
28 feature renders it particularly appropriate for an  
Internet environment.

24 Mot., Ex. 2, at 18:49-61. See also '821 Reexam. Ex. 5 at 10. The  
25 specification goes on to state that the user may then select a  
26 further criteria, "generating a selection criteria 14 different  
27 from that which was set [sic] to it. The client 126 initiates a  
28 search with the modified selection criteria 14. The client 126

1 sends to the server 125, the ScreenNum 102 value sent to it by the  
2 server, and the modified selection criteria," the resubmission,  
3 which the server then uses to execute the search. Mot., Ex. 2, at  
4 18:64-19:5. This is a level of detail analogous to that in the  
5 Arnett reference. Lockwood, 107 F.3d at 1570 (rejecting  
6 patentee's arguments where the "patent itself does not disclose  
7 the level of detail that [the patentee] would have us require of  
8 the prior art"). Further, the fact that the patent did not  
9 explain how to perform resubmission implies that persons of  
10 ordinary skill in the art would know how to do so. See Spectra-  
11 Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534 (Fed. Cir.  
12 1987) ("A patent need not teach, and preferably omits, what is  
13 well known in the art.").

14 Defendants' expert provides evidence that a person of  
15 ordinary skill in the art at the time of the invention would have  
16 been able to implement resubmission in a web server arrangement,  
17 through one of several known design methods. See Larson II Decl.  
18 ¶¶ 44-50. Kelora and its expert do not dispute this fact, and  
19 argue only that a person of ordinary skill would not have been  
20 able to implement resubmission with the source code of the AMP  
21 Navigator demonstration program. This argument does not raise a  
22 dispute of material fact, as already addressed.

23 Thus, Defendants have demonstrated that the Arnett reference  
24 taught a person of ordinary skill at the time of the invention of  
25 the re-examined '821 claims that resubmission was one available  
26 approach to address the issue of statelessness and that it was  
27 within the technical grasp of such a hypothetical person.  
28

e. Motivation to combine prior art references

"Generally, a party seeking to invalidate a patent as obvious must demonstrate by clear and convincing evidence that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so." In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig., 2012 U.S. App. LEXIS 7571, at \*10 (Fed. Cir.) (internal citations omitted). In KSR, the Supreme Court emphasized that this is to be a "flexible inquiry" in which a court should "take account of 'the inferences and creative steps,' or even routine steps, that an inventor would employ." Ball Aerosol & Spec. Container v. Ltd. Brands, 555 F.3d 984, 993 (Fed. Cir. 2009). See also Perfect Web Techs., Inc. v. InfoUSA, Inc., 587 F.3d 1324, 1329 (Fed. Cir. 2009) (noting the obviousness inquiry may "include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion").

Defendants offer evidence that one of ordinary skill in the art would have been motivated to combine the teachings of AMP Navigator with a client-server arrangement. See Larson II Decl. ¶¶ 32-33. As previously noted, this is further supported by the opinion of the patent examiner. See '444 Prosecution, No. 7 ¶ 28. Kelora does not offer any evidence creating a material dispute of fact as to this point. While Kelora's expert, Mr. Gafford, opines that a person of ordinary skill would not have reason to combine the Suzuki client-server arrangement with AMP Navigator, he states that this is because Suzuki teaches nothing not already contained

1 in AMP Navigator, "other than, possibly, a remote database."  
2 Gafford Decl. ¶ 43. He offers no evidence to dispute that a  
3 person of ordinary skill in the art would be motivated to combine  
4 these. He further concedes that, combining the two, one of  
5 ordinary skill in the art would be expected to achieve "a system  
6 with the logical model of the AMP Navigator demonstration program,  
7 . . . coupled with a remote database." Id.

8 Defendants also offer evidence that persons of ordinary skill  
9 in the art would have been motivated to adapt a client-server  
10 arrangement to the Internet. Larson II Decl. ¶ 36. Kelora's  
11 expert does not challenge this basic motivation. See Gafford  
12 Decl. ¶ 47 ("Motivation to adapt applications, in general, to the  
13 web, is not contested.").

14 Finally, as discussed above, the Arnett reference describes  
15 the concept of resubmission as being a potential solution for the  
16 then-known problem of statelessness with web server protocols, and  
17 thus provides motivation to combine resubmission with a client-web  
18 server arrangement. Further, as previously found, a person of  
19 ordinary skill in the art would have expected to achieve success  
20 in doing so. The Court has already addressed and rejected  
21 Kelora's arguments against these findings.

22 Accordingly, the Court finds that there are no genuine issues  
23 of materially disputed facts as to whether there was a motivation  
24 to combine the various teachings.

25 f. Cumulative to references before the  
26 Examiner

27 Kelora argues that Defendants' proffered prior art references  
28 are cumulative to those before the Patent Examiner and that this

1 Court should defer to the Examiner's decision to grant the  
2 reexamination certificate over those teachings.

3 The Court declines to do so because, as Defendants pointed  
4 out at the hearing and in their renewed motion, the primary prior  
5 art references relied on by this Court were either not submitted,  
6 or not explained, to the Examiner. The Arnett reference was not  
7 given to the Examiner. Further, the AMP Navigator prior art was  
8 not before the Examiner, because re-examinations are limited to  
9 prior art patents or printed publications, and not public use or  
10 sale. See Manual of Patent Examining Procedure § 2258. While the  
11 Suzuki reference was before the Examiner, it was not discussed or  
12 addressed by the patentees, and "the requisite degree of  
13 consideration to be given to such information will be normally  
14 limited by the degree to which the party filing the information  
15 citation has explained the content and relevance of the  
16 information." Id. § 2256.

17 3. Secondary considerations of obviousness

18 Kelora argues that evidence of the commercial success of the  
19 claimed invention precludes summary judgment. While such evidence  
20 may be relevant "to the overall obviousness determination, . . . a  
21 nexus must exist between the commercial success and the claimed  
22 invention." Tokai Corp. v. Easton Enters., 632 F.3d 1358, 1369  
23 (Fed. Cir. 2011) (internal citations omitted). "If commercial  
24 success is due to an element in the prior art, no nexus exists."  
25 Id. (citations omitted). Kelora points specifically to the  
26 declaration of Mr. Danish, discussing the commercial success of  
27 the "guided parametric search technology" in the '821 patent.  
28 Danish Decl. ¶¶ 2-10. However, that feature was part of the

1 original patent which was previously put into the public domain  
2 through Mr. Danish's offer for sale. Kelora points to no evidence  
3 that suggests commercial success due to elements not in the prior  
4 art.

5 Further, even if Kelora had offered evidence of a nexus, such  
6 evidence would be insufficient to overcome the strong showing of  
7 obviousness made here. See Media Techs. Licensing, LLC v. Upper  
8 Deck Co., 596 F.3d 1334, 1339 (Fed. Cir. 2010) ("a highly  
9 successful product alone would not overcome the strong showing of  
10 obviousness").

11 4. The dependent claims

12 For the foregoing reasons, the Court finds that there is no  
13 material dispute of fact that claims one and nine are invalid due  
14 to obviousness. Defendants make additional arguments as to why  
15 the modifications of dependent claims two, three and four are also  
16 obvious. However, Kelora disputes the obviousness of the  
17 dependent claims only to the extent that it disputes the  
18 obviousness of the re-examined claims one and nine. Thus, because  
19 the Court has found that claims one and nine are obvious, there is  
20 also no material dispute of fact that the dependent claims are  
21 obvious as well.

22 C. Summary Judgment of Non-Infringement and of Invalidity  
23 on other grounds

24 Because the Court has concluded that claims one through four  
25 and nine are invalid due to obviousness, the remainder of  
26 Defendants' motion, to the extent it seeks summary judgment of  
27 invalidity on other grounds and of non-infringement, is moot.  
28 See, e.g., Princeton Biochems., Inc. v. Beckman Coulter, Inc., 411

1 F.3d 1332, 1339-40 (Fed. Cir. 2005)("Because claim 32 is invalid  
2 for obviousness, this court need not reach the issues of prior  
3 invention and infringement."); Richdel, Inc., v. Sunspool Corp.,  
4 714 F.2d 1573, 1580 (Fed. Cir. 1983)("The claim being invalid,  
5 there is nothing to be infringed."). Thus, the Court does not  
6 reach Defendants' other arguments.

7 CONCLUSION

8 For the reasons set forth above, the Court construes the  
9 disputed claim language in the manner explained and GRANTS  
10 Defendants' motion for summary judgment of invalidity (Docket Nos.  
11 94 in 10-4947, 57 in 11-1398 and 361 in 11-1548). The Clerk shall  
12 enter judgment and close the file. Defendants shall recover their  
13 costs from Kelora.

14 IT IS SO ORDERED.

15  
16 Dated: 5/21/2012

17   
18 CLAUDIA WILKEN  
19 United States District Judge  
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